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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/042,686 | 03/14/2000 | David J. Luneau | 1090-006 | 1741 |
| 26161 | 7590 | 05/05/2005 | EXAMINER | |
| FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110 | | | NGUYEN, LEE | |
| | | ART UNIT | | PAPER NUMBER |
| | | 2682 | | |

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|--|------------------------|--|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/042,686 | LUNEAU, DAVID J. | |
| | Examiner LEE NGUYEN | Art Unit 2682 | |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i> | | | |
| Period for Reply | | | |
| A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION. | | | |
| <ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). | | | |
| Status | | | |
| 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>16 December 2004</u> . | | | |
| 2a) <input checked="" type="checkbox"/> This action is FINAL . 2b) <input type="checkbox"/> This action is non-final. | | | |
| 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213. | | | |
| Disposition of Claims | | | |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>18-63</u> is/are pending in the application. | | | |
| 4a) Of the above claim(s) _____ is/are withdrawn from consideration. | | | |
| 5) <input checked="" type="checkbox"/> Claim(s) <u>18-51</u> is/are allowed. | | | |
| 6) <input checked="" type="checkbox"/> Claim(s) <u>52-53, 55-58, 60-63</u> is/are rejected. | | | |
| 7) <input checked="" type="checkbox"/> Claim(s) <u>54 and 59</u> is/are objected to. | | | |
| 8) <input type="checkbox"/> Claim(s) _____ are subject to restriction and/or election requirement. | | | |
| Application Papers | | | |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner. | | | |
| 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). | | | |
| 11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner. If approved, corrected drawings are required in reply to this Office action. | | | |
| 12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner. | | | |
| Priority under 35 U.S.C. §§ 119 and 120 | | | |
| 13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. | | | |
| 14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application). a) <input type="checkbox"/> The translation of the foreign language provisional application has been received. | | | |
| 15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121. | | | |
| Attachment(s) | | | |
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . | |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) | |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | | 6) <input type="checkbox"/> Other: _____ . | |

DETAILED ACTION

1. This action is responsive to the communication filed 12/16/2004.

Double Patenting

2. Applicant will file a terminal disclaimer upon receipt of a notice of allowability as shown in the remarks.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 52-53, 55, 57-58, 60, 62-63 are rejected under 35 U.S.C. 102(e) as being anticipated by Lim (US 5,265,145) submitted by Applicant.

Regarding claim 52, Lim teaches a caller announcement apparatus (fig. 1) for a telephone system that provisions a telephone call between a caller telephone at a caller station and a called telephone at a called station, where the caller station is associated with an identity (col. 3, line 7), where the telephone system provides signals to the called station that include caller identification signals, the caller announcement apparatus comprising:

a signal receiver 5, 6 at the called station operatively connected to the telephone system to receive signals therefrom, the signal receiver being operative to extract caller identification signals from the signals received from the telephone system and to provide caller identification data corresponding to the extracted caller identification signals (col. 2, line 34); memory storage 13 (voice recording/reproducing IC) for storing audio identity information associated with the caller identification data stored in RAM ;

a processing unit 8 operatively connected to the signal receiver to receive caller identification data therefrom, the processing unit being operative to access the memory storage to retrieve stored audio identity information associated with the caller identification data (col.

2, lines 45-51); an audio announcing circuit 16 operatively connected to the processing unit 8 to receive identity information therefrom, the audio announcing circuit being operative to use the retrieved identity information to produce audio using the audio transducer (col. 2, lines 41-45).

Regarding claims 57, 62-63, the method claims are interpreted and rejected for the same reason as set forth in the apparatus claim 52.

Regarding claims 53, 58, Lim also teaches that the telephone includes the transducer 15 (fig. 1).

Regarding claims 55, 60, Lim also teaches for storing the name of the caller (col. 3, line 7).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 56, 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lim in view of Figa et al. (US 4,924,496).

Regarding claims 56, 61, Lim does not explicitly teach that the identity information associated with the caller identification data is audio information corresponding to a geographical location associated with the caller station. Figa teaches that the identity information associated with the caller identification data is audio information corresponding to a geographical location associated with the caller station (fig. 2, numeral 34, area code 617). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Figa to the apparatus of Lim in order to provide the user with the area code of the caller.

Allowable Subject Matter

7. Claims 18-51 are allowed.

Claims 18-51 are allowed as indicated in the remarks of record.

8. Claims 54, 59 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 54 and 59 are also allowable for the same reason as set forth above.

Response to Arguments

9. Applicant's arguments with respect to claims 18-51 have been considered but are moot in view of the allowance.
10. Applicant's arguments concerning the rejection of claims 52-53, 55-58, 60-63 have been fully considered but they are not persuasive.

Applicant again "unreasonably" argues that Lim only stored digital text information, not audio information.

Applicant is requested to explain the meaning of the term "voice recorder" in column 2, line 57 of Lim, rather than pointing away passages in the Lim reference. The voice recorder can not be read as text recorder and one having skill in the art can recognize this difference.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LEE NGUYEN whose telephone number is (571)-272-7854. The examiner can normally be reached on 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VIVIAN CHIN can be reached on (703) -272-7848.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


LEE NGUYEN 4/20/05
Primary Examiner
Art Unit 2682